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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,960	01/19/2001	Mitsukazu Momosaki	ALPHA 3.0-001	9159

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EXAMINER

PRONE, JASON D

ART UNIT PAPER NUMBER

3724

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,960

Applicant(s)

MOMOSAKI, MITSUKAZU

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,8,11,12,15 and 17 is/are allowed.
- 6) ☒ Claim(s) 7,9,10,13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the corner cutter with the space between one of the two opposing outer portions of the first and the second blade edges is less than the space between the other of the opposing outer portions of the first and said second blade edges including "first and said second blade edges each have outer portions and an inner portion and the distance between the opposing outer portions of said first and second blade edges is less than the distance between said inner portions of said first and second blade edges", of claim 7, including the "return spring", of claim 9, including the "stop means", of claim 10, including the "guide" of claim 13, and including that "the arcuate curved first and second blade edges are concave", of claim 16, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

Art Unit: 3724

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7, 9, 10, 13, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The addition of the paragraph, "said first and said second blade edges each have two opposing outer portions and an opposing inner portion and the space between one of the two opposing outer portions of said first and said second blade edges is less than the space between the other of said opposing outer portions of said first and said second blade edges" to claim 6 has created a new matter situation. From now on the newly added paragraph, to claim 6, will be referred to as "new paragraph". The instant application discloses two separate embodiments that incorporate limitations not found in the other of the embodiments.

The "new paragraph" describes limitations found in solely in the second embodiment.

Therefore, with the addition of the "new paragraph", claim 6 is no longer a generic claim and only discloses the second embodiment.

4. Claim 7 discloses limitations shown in Figure 3 that refer to the first embodiment only. Claim 6, with the "new paragraph", discloses limitations shown in Figure 10 from the second embodiment. There is no support, from the specification, that discloses how the corner cutter could employ both the limitations of Figure 3/claim 7 and Figure 10/claim 6 in the same apparatus.

5. Claim 9 discloses the limitation of "a return spring connected between the upper and lower handles" which is only shown in Figure 1, which is the first embodiment. There is no support from the specification or Figures that discloses the second embodiment incorporating a return spring type structure.

6. Claim 10 discloses the limitation of "a stop mean" which is only shown in Figures 1 and 2, which are the first embodiment. There is no support from the specification or Figures that discloses the second embodiment incorporating a stop means type structure.

7. Claim 13 discloses the limitation of "a guide" which is only shown in Figures 14-16, which are part of the first embodiment. There is no support from the specification or Figures that discloses the second embodiment incorporating guide type structure.

8. Claim 16 discloses limitations shown in Figure 2 that refer to the first embodiment only. Claim 6, with the "new paragraph", are limited to the structure of the second embodiment. The second embodiment clearly, as shown in Figure 11, incorporates a

convex arcuate curved first and second blade edges. There is no support, from the specification, that discloses how the corner cutter could employ both the limitations of Figure 2/claim 16, that the arcuate curved first and second blade edges are concave and Figure 11/claim 6 that the arcuate curved first and second blade edges are convex, in the same apparatus.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 7, 9, 10, 13, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. In regards to claim 7, it is unclear what structure the apparatus must take on to incorporate the limitations of claim 7 and the "new paragraph". The "new paragraph" no longer allows claim 6 to be generic but solely with the second embodiment. Claim 7 is dependant from claim 6 and has limitations that are solely incorporated by the first embodiment. It is unclear what structure allows the apparatus to incorporate both the limitations of claim 6 and 7.

12. In regards to claim 9, the limitation "a return spring" is also only shown and disclosed as a limitation for the first embodiment. It is unclear what structure the return spring entails and where it would be located in the second embodiment as disclosed by independent claim 6.

13. In regards to claim 10, the limitation "a stop means" is also only shown and disclosed as a limitation for the first embodiment. It is unclear what structure the stop

Art Unit: 3724

means entails and where it would be located in the second embodiment as disclosed by independent claim 6.

14. In regards to claim 13, the limitation "a guide" is also only shown and disclosed as a limitation for the first embodiment. It is unclear what structure the guide entails and where it would be located in the second embodiment as disclosed by independent claim 6.

15. In regards to claim 16, it is unclear what structure the apparatus must take on to incorporate the limitations of claim 16 and the "new paragraph". The "new paragraph" no longer allows claim 6 to be generic but solely with the second embodiment. Claim 16 is dependant from claim 6 and has limitations that are solely incorporated by the first embodiment. It is unclear what structure allows the apparatus to incorporate both the limitations of claim 6 and 16.

Response to Arguments

16. Applicant's arguments with respect to claims 7, 9, 10, 13, and 16 have been considered but are moot in view of the new ground(s) of rejection. The amendment to independent claim 6, from which claims 7, 9, 10, 13, and 16 depend, no longer allows claim 6 to be a generic claim for both the first and second embodiment. The "new paragraph" narrows claim 6 by adding a limitation only found in the second embodiment. Therefore, each of the rejected claims incorporate structure that is only shown/disclosed with the first embodiment. Support for each of these limitations with the second embodiment must be incorporated into the specification. A Figure

Art Unit: 3724

incorporating the limitations of the "new paragraph" and the limitations of each of the rejected claims are also required.

Allowable Subject Matter

17. Claims 6, 8, 11, 12, 15, and 17 are allowed.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meesook and d'Orgelys.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/765,960

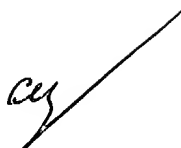
Page 8

Art Unit: 3724



JP

September 13, 2004



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